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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,529	10/31/2003	Robert H. Wollenberg	T-6298 (538-59)	2770

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EXAMINER

WALLENHORST, MAUREEN

ART UNIT	PAPER NUMBER
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1797

MAIL DATE	DELIVERY MODE
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05/02/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/699,529

Applicant(s)

WOLLENBERG ET AL.

Examiner

Maureen M. Wallenhorst

Art Unit

1797

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 18-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 18-32 is/are rejected.
- 7) ☒ Claim(s) 33-35 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

1. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
2. Claims 33-35 are objected to because of the following informalities: On line 6 of claim 33, the phrase "each of a plurality of different lubricating oil compositions" should be changed to --each of said plurality of different lubricating oil compositions-- so as to refer to the plurality of different lubricating oil compositions recited in part (a) of claim 33. Appropriate correction is required.
3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
4. Claims 1-16 and 18-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The added limitation to independent claims 1 and 20 concerning the plurality of different lubricating oil compositions having a phosphorous content at or below 0.08 wt.% and a sulfur content below 0.2 wt.% is new matter because nowhere in the specification, as originally

filed, is it taught that each of the different lubricating oil compositions in the library each have these levels of phosphorous and sulfur therein. The only place in the specification where the phosphorous and sulfur content of lubricating oil compositions is mentioned is on page 2 where it is described how the U.S. Military Standards MIL-L-46152E and the ILSAC Standards defined by the Japanese and U.S. Automobile Industry Association have **proposed** that the phosphorous content be lowered to 0.08 wt% by January 2004 and below 0.05 wt.% by January 2006, and that the sulfur content be lowered to below 0.2 wt.% by January 2006. However, there is no indication in the specification that the lubricating oil compositions actually present in the combinatorial library have these low levels of phosphorus and sulfur, especially since the standards set forth by the Japanese and U.S. Automobile Industry Association are only proposals, not actual laws to be enforced. In addition, since this application was filed on October 31, 2003 before the dates mentioned by the standards of the Japanese and U.S. Automobile Industry Association on page 2 of the specification (i.e. January 2004 and January 2006), there is no presumption that the lubricating oil compositions in the combinatorial library of the instant application filed before January 2004 and January 2006 have a phosphorous content of at or below 0.08 wt.% and a sulfur content below 0.2 wt.%, as now recited in the claims. For these reasons, claims 1-16 and 18-32 contain new matter not supported by the specification as originally filed.

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 20 and 22-23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 13-14 and 21 of copending Application No. 10/699,510. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims recite a method for producing a combinatorial library of different lubricating oil compositions by combining a major amount of a base oil of lubricating viscosity with a minor amount of an oil additive to form a plurality of lubricating oil composition samples, and placing the samples in a plurality of test reservoirs. In addition, both sets of claims recite analyzing the lubricating oil composition samples for property data. Since the same type of lubricating oil compositions (i.e. engine oils, marine oils, etc) are included in the combinatorial library of this application and application serial no. 10/699,510, it is presumed that the phosphorous and sulfur content of the compositions in both applications are the same.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Applicant's arguments filed March 7, 2008 have been fully considered but they are not persuasive.

The previous rejections of the claims under 35 USC 112, second paragraph made in the last Office action mailed on December 4, 2007 have been withdrawn in view of Applicants'

amendments to the claims. However, claims 33-35 are objected to, as set forth above, as necessitated by Applicants' amendment to claim 33. All of the previous rejections of the claims under the judicially created doctrine of obviousness-type double patenting have been withdrawn in view of the appropriately filed terminal disclaimers received on March 7, 2008, with the exception of the rejection of the claims as being unpatentable over claims in application serial no. 10/699,510. The obviousness-type double patenting rejection over 10/699,510 is maintained since contrary to Applicant's argument, application serial no. 10/699,510 is still pending since the abandonment of 10/699,510 was withdrawn, as per the notice mailed in that application on February 20, 2008.

Applicants argue the rejection of the claims under 35 USC 112, first paragraph by stating that the specification as originally filed does fully describe the plurality of different lubricating oil compositions as having a phosphorus content at or below 0.08 wt% and a sulfur content below 0.2 wt% since the presence of literal support in the specification for the claim language is not required, and the specification describes that when product requirements change, appropriate combinations of the lubricating oil compositions in the library can be selected to prepare a desired product. Applicants' arguments are not found persuasive since although exact literal support in the specification for claim language is not necessarily required, it is not clear from the specification that the proposed lubricating oil compositions in the library have the desirable values of phosphorus and sulfur (i.e. a phosphorus content of at or below 0.08 wt% and a sulfur content of below 0.2 wt%). While the specification describes selecting lubricating oil compositions according to the properties desired by the end user, it is not clear that the properties desired by the end user would correspond to a phosphorus content of at or below 0.08 wt% and a

sulfur content of below 0.2 wt%. There is no indication that the desired product has the phosphorus and sulfur content as recited in the instant claims, only that a desired product may be obtained from the library by choosing appropriate combinations of the lubricating oil compositions from the library. Nowhere in the specification is the specific phosphorus and sulfur content of any of the lubricating oil compositions actually present in the library of the invention disclosed or described. Contrary to Applicants' argument, one skilled in the art would not clearly understand what the specific phosphorus or sulfur content of the lubricating oil compositions in the library are since nowhere is this taught in the specification by description or data.

For the above reasons, Applicants' arguments are not found persuasive.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maureen M. Wallenhorst whose telephone number is 571-272-1266. The examiner can normally be reached on Monday-Thursday from 6:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden, can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Maureen M. Wallenhorst
Primary Examiner
Art Unit 1797

mmw

April 30, 2008

/Maureen M. Wallenhorst/

Primary Examiner, Art Unit 1797